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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/080,806	02/21/2002	Franz Josef Gassmann	298-154	9917

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EXAMINER MAHONEY, CHRISTOPHER E	
ART UNIT 2851	PAPER NUMBER

DATE MAILED: 09/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

11

Office Action Summary

Application No.

10/080,806

Applicant(s)

GASSMANN, FRANZ JOSEF

Examiner

Christopher E. Mahoney

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date April 24, 2006.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Page 4 lines 7-12 of the specification does not support the limitation of wherein the one or more white light spots with known spectral intensity distribution and/or chromaticity coordinates and/or brightness, which are recorded at the **same time as a picture is taken**.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claim 34 is rejected under 35 U.S.C. 102(b) as being anticipated by Schwartz (U.S. Pat. No. 4,511,229). Schwartz teaches a recording device for recording image information on a recording medium characterized in that the recording device comprises one or more light sources (col. 5, lines 20 and 25) for creating and emitting light signals, which light signals are independent of the illumination conditions (col. 5, lines 17-18) of the object from which the image is taken and which light signals have known spectral intensity distribution and or chromaticity coordinates and/or brightness, wherein said light sources are located in the camera (col. 5, lines 23-24) such that said signals which are emitted from the light sources are recorded on said recording medium 270 positioned in the recording device that the light signal as well as the image information are recorded on the same recording medium.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwartz et al. (USPN 4511229) in view of Kaplan (USPN 4977521) In reference to claim 1, 11-13,16, 19 and 20, Schwartz et al. discloses a recording device for recording an image information, characterized by the fact that the recording device has one or more media for creating light signals with know spectral intensity distribution and/or chromaticity coordinates and/or brightness, col. 3 lines 1-17 and col. 5 lines 23-27, which are recorded at the same time as a picture is taken by means of a recording medium, ref. 270, positioned in or capable of being

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positioned in or capable of being positioned in the recording device, col. 6 lines 49-56. Schwartz et al. invention is directed to color compensation and therefore uses colored light signals instead of the claimed limitation of one or more white light spots. Kaplan discloses a means for corrected variations in a photographic medium by printing a calibration pattern on the medium after the medium is exposed, col. 5 line 66 – col. 6 line 11. Kaplan further discloses wherein the calibration pattern is based on a gray scale (varying brightness), col. 6 lines 9-11. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate a calibration pattern utilizing varying brightness in the camera of Schwartz et al. This would be done to allow for calibration of black and white films that are interchangeably with color films used in the single lens reflex cameras disclosed by Schwartz et al.

In reference to claim 2, Schwartz et al. discloses wherein the light signal has wavelengths in the visual range or in the range of shorter wavelengths, col. 4 lines 9-12.

In reference to claim 3, Schwartz et al. discloses wherein the light signal consists of white light, col. 5 lines 16-22.

In reference to claim 4, Schwartz et al. discloses wherein by means of the light-signal-creating media several separate light signals with respective known chromaticity coordinates that can be recorded by the recording medium can be created, col. 5 lines 23-27.

In reference to claim 5, Schwartz et al. discloses wherein several spatially and/or spectrally separate light signals can be created, col. 5 lines 23-27.

In reference to claim 6, Schwartz et al. discloses wherein by means of the light-signal-creating media light a red, a green and a blue light signal can be created, col. 5 lines 23-27.

In reference to claim 7, Schwartz et al. discloses wherein the red, the green, and the blue light signals together produce white light, col. 5 lines 17-27

In reference to claim 8, Schwartz et al. discloses wherein by means of the light-signal-creating media a light signal complementary to red, a light signal complementary to green, and a light signal complementary to blue can be created, col. 5 lines 54-57 and col. 3 lines 13-17 (any colors from the "Macbeth" test chart can be selected).

In reference to claim 10, Schwartz et al. discloses wherein the camera is an analog or digital photo camera, an analog or digital movie camera, or a TV camera, col. 3 lines 35-37.

In reference to claim 14, Schwartz et al. discloses wherein the camera or the recording medium is executed in such manner that the image information is recorded in several spectral ranges, col. 5 lines 23-27.

In reference to claim 15, Schwartz et al. discloses wherein the image formation is recorded in the three spectral ranges of red, green, and blue, or complementary ranges, or between the blue/green and green/red ranges or ranges complementary thereto, and the light-signal-creating media are executed in such manner that the light signal can be recorded in each of these spectral ranges, col. 5 lines 23-27.

In reference to claim 17, Schwartz et al. discloses wherein the light-signal-creating media include light-emitting diodes, incandescent lamps, laser diodes, fluorescent diodes, luminance diodes, glow lamps, or other light media, col. 5 lines 23-27.

In reference to claim 18, Schwartz et al. discloses wherein the light-signal-creating media have one or more chromaticity and/or intensity filters positioned between the lighting medium and the recording medium, col. 6 lines 28-31

In reference to claim 21, Schwartz et al. discloses wherein the calibration parameters are used to minimize the divergence of the reconstructed light signal from the camera-created light signal or the light signal complementary thereto in the image reconstruction, col. 4 lines 57-68.

In reference to claim 22, Schwartz et al. discloses a camera with film or an electronic device positioned within the camera as recording media, an imaging or camera lens positioned in front of an opening into the camera and arranged to create an image of an object outside the camera upon the recording media, col. 6 lines 35-52.

In reference to claim 23, Schwartz et al. discloses wherein the recording medium is film, the light-signal-creating element is positioned in front of the film, col. 6 lines 35-52. Schwartz et al. does not disclose an imaging lens for the light-signal-creating element positioned between the same and film. It would have been obvious to one of ordinary skill in the art at the time of the invention to realize that a imaging lens could be incorporated between the light-signal-creating element and the film. Schwartz et al. discloses that LEDs could be used as the light-signal creating element, col. 5 lines 24-27. One would incorporate an imaging lens to concentrate the light on the film if the distance between the LEDs and the film was too great.

In reference to claim 24-26, Schwartz et al. discloses wherein the recording media is a film comprising an image area and recorded/developed light signal points of a light-signal-creating element for white light, white light having different intensity values or white light split in spatial separated RGB-points, col. 3 line 55 – col. 4 line 18.

Response to Arguments

Applicant's arguments filed April 24, 2006 have been fully considered but they are not persuasive.

The applicant states that the examiner recommended filing a Petition setting forth applicant's position in detail for withdrawing finality. Applicant's representative was simply informed that a response to the Final rejection needed to be filed within the appropriate time frame and that the applicant could set forth reasons for withdrawing finality in that response. For the examiner, a request for withdrawing finality is now moot with the filing of the RCE on April 24, 2006.

Regarding the rejection of the claims under 35 USC 112, 1st paragraph, the applicant refers to the declaration and summarizes that the specification only makes sense if the reference signal is recorded at the same time as the image. It would appear that the same result could be achieved if the reference signal were recorded immediately before or immediately after the image was recorded. Clarification is respectfully requested as to how recording at the same time would provide different results than recording immediately before or after imaging. Additionally, it is unclear why recording the light spot(s) at the same time as imaging is not mentioned anywhere in the specification if it is crucial enough to be recited in the claims and argued as a distinguishing feature.

The applicant argues that Schwartz does not teach one or more light spots but several colors. The use of white light spots is taught by the secondary reference, Kaplan.

The applicant then argues that the claimed invention records the spots independent of illumination conditions. Schwartz teaches using a known reference source or LEDs when not sampling the illumination source. If the illumination source is not sampled, then the spots would be independent of the illumination conditions.

The applicant argues that Kaplan has to do with reducing noise and has nothing to do with compensating for aging of film. Schwartz already addresses compensation for aging of film. Is explicitly mentioned in col. 5, lines 14-15. Additionally, Kaplan reduced noise. Aging of film can produce noise.

The applicant further argues the combination of Schwartz in view of Kaplan reciting that there would be no reason to utilize a noise reduction system with a system that records lighting conditions. Schwartz is not solely directed to a system to record lighting conditions. As discussed supra, Schwartz teaches recording a test set independent of the lighting conditions in order to create an optimized final image. Kaplan is also directed to producing an optimized final image.

The applicant argues that using the apparatus of Schwartz would destroy the histogram function of Kaplan. This is again based on the assumption that Schwartz is recording lighting information. The applicant has not discussed the combination when a known light source is used. Both references recite using a known light source for exposure.

Response to Amendment

The Declaration under 37 CFR 1.132 filed June 23, 2006 is insufficient to overcome the rejection of the claims based upon 35 USC 103 and 35 USC 112 as set forth in the last Office action because:

The applicant has not distinguished the differences between the applied prior art and the present invention *as claimed*.

The applicant states that the specification only makes sense if the reference signal is recorded at the same time as the image. The examiner has referenced MPEP 716.01(c) III in considering these statements. A relevant portion recites:

“In assessing the probative value of an expert opinion, the examiner must consider the nature of the matter sought to be established, the strength of any opposing evidence, *the interest of the expert in the outcome of the case*, and the presence or absence of factual support for the expert’s opinion. *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986).” [emphasis added]

Based upon a review of MPEP 716.01(c) III, it would seem that the statement/conclusions of the exposure being simultaneous with the imaging would hold more weight if derived by one of ordinary skill in the art with no interest in the outcome of the application. Additionally an explanation is respectfully requested as to why the light spot can not be recorded immediately before or after the image with the same result.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher E. Mahoney whose telephone number is (571) 272-2122. The examiner can normally be reached on 8:30AM-5PM, Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Diane Lee can be reached on (571) 272-2399. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'C. E. Mahoney', with a stylized flourish at the end.

Christopher E Mahoney
Primary Examiner
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